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***Shnuggle v Munchkin*: Don't throw the baby out with the bathwater!**

Jane Cornwell *

Designs; registered Community designs; UK unregistered design right; infringement; validity.

In Shnuggle v Munchkin, Clarke J sitting in IPEC has delivered a judgment which provides an interesting illustration of registered Community designs and UK unregistered design right in action. The case also engages with, but does not resolve, important on-going points of legal uncertainty in relation to the definition of protectable 'design' and the requirement of originality in UK UDR.

Introduction

In *Shnuggle v Munchkin*,¹ Clarke J sitting in the Intellectual Property Enterprise Court has issued an interesting judgment on registered Community design ('RCD') and UK unregistered design right ('UK UDR') protection.

The claimant, Shnuggle, was a small Northern Ireland-based company operating in the design, manufacture and sale of baby products. The dispute related to baby baths. As Clarke J noted, the market for baby baths has become sophisticated, with many different designs available.² The first contested design, referred to as the 'Shnuggle Mk 1', was for a style of baby bath launched by Shnuggle in 2014. Shnuggle undertook further design work and a second design, the 'Shnuggle Mk 2', was launched in 2015. Shnuggle owned two registered Community designs, RCD-196 and RCD-763, corresponding in essence to the Shnuggle Mk 1 and Mk 2. The Shnuggle Mk 2 achieved considerable global commercial success.³

The first defendant, Munchkin, was a large US-based competitor.⁴ The allegedly infringing product was Munchkin's 'Sit & Soak' baby bath, designed by Munchkin in 2017 and first sold in the UK in 2019.⁵ Images of (from left to right) the Shnuggle Mk 1, Shnuggle Mk2 and Munchkin 'Sit & Soak' are at Figure 1.⁶

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¹ *Shnuggle Ltd v Munchkin Inc, Lindam Limited* [2019] EWHC 3149 (IPEC) (currently unreported).

² *Shnuggle*, [1].

³ *Shnuggle*, [2]-[6].

⁴ *Shnuggle*, [2]. The joint liability of the second defendant, Munchkin's UK-based subsidiary, was accepted in the event of a finding of infringement: *Shnuggle*, [14].

⁵ *Shnuggle*, [8].

⁶ *Shnuggle*, [9].

Figure 1: Shnuggle Mk 1, Shnuggle Mk2 and Munchkin ‘Sit & Soak’



Shnuggle sued for infringement of its two RCDs and of six UK UDR-protected designs which Shnuggle claimed subsisted in particular elements of the Shnuggle Mk 1 and Mk 2. Munchkin accepted that the Shnuggle Mk 2 had been a point of reference and inspiration for the ‘Sit & Soak’,⁷ but denied RCD and UK UDR infringement. Munchkin also disputed the subsistence of UK UDR protection and counterclaimed for invalidation of RCD-763, the later-filed of the two Shnuggle RCDs.⁸

Shnuggle’s registered Community designs

By Article 10(1) Community Design Regulation 6/2002/EC, the scope of protection conferred upon an RCD includes any design which does not produce on the informed user a different overall impression to the registered design. The degree of freedom of the designer is to be taken into consideration in assessing scope of protection,⁹ meaning that similarities between designs which are attributable to design constraints are taken to have relatively little significance in the eyes of the informed user.¹⁰ Design features common in the design corpus are also discounted a similar way.¹¹ These rules are mirrored in the RCD validity requirement of ‘individual character’, which will be met if the overall impression produced by the registered design on the informed user differs from the overall impression produced on such a user by any earlier design made available to the public.¹²

Representations from Shnuggle’s RCDs, showing views of the registered designs from the side and above, are at Figure 2. Clarke J started by considering infringement of RCD-196, the earlier of Shnuggle’s two filings.

⁷ *Shnuggle*, [8].

⁸ A challenge to the validity of RCD-196 was not pursued at trial, although the judge did briefly address and confirm its novelty and individual character: *Shnuggle*, [13] and [41]-[42].

⁹ Article 10(2) Community Design Regulation.

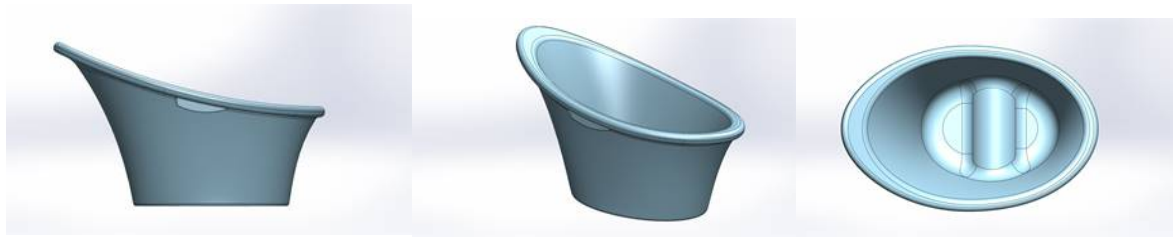
¹⁰ *Shnuggle*, [33].

¹¹ *Shnuggle*, [33].

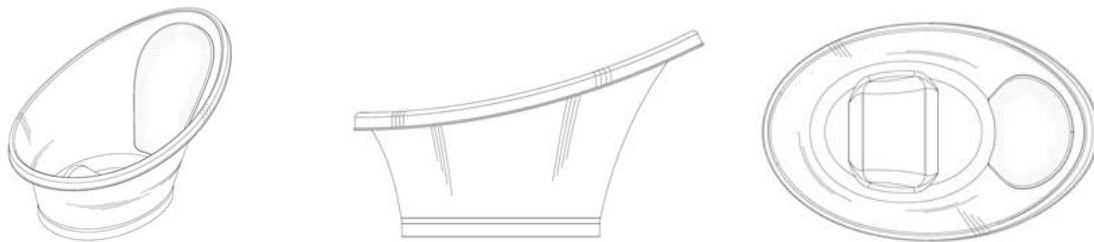
¹² Article 6(1) Community Design Regulation. The requirement of novelty (Arts 4 and 5 Community Design Regulation) was not a live issue in this case.

Figure 2: Shnuggle's RCDs

RCD-196



RCD-763



Clarke J began by considering the characterisation of the ‘informed user’. Following guidance given in *Samsung v Apple*,¹³ on the facts, the informed user was an ‘interested and observant adult user of baby baths who may be a parent, carer, or relative of the baby who is to use it’.¹⁴

It was common ground that, in the general market for baby baths of which the informed user would have been aware, the design corpus was wide and varied.¹⁵ However, Munchkin argued that there were design constraints which should be taken into account when assessing the scope of protection conferred on RCD-196. Clarke J accepted some, but not all of these.¹⁶ Overall, there was a large degree of design freedom in relation to the size (within a range), shape and overall appearance of baby baths, as evidenced by the wide range of styles in the design corpus.¹⁷

Munchkin also submitted (and Shnuggle accepted) that there were various design features which were common within the baby bath design corpus, including the use of an overall ‘slipper’ shape (where the back of the bath is higher than the front), an ellipse or oval shape for the base and top, an angled and/or padded back, narrower base and wider top, and ‘bum bump’ (a bump in the base of the bath intended to stop a seated baby from slipping down into the bath).¹⁸ Given their common appearance in the design corpus, little or no weight was to be given to similarities in these features in RCD-196 and the ‘Sit &

¹³ *Shnuggle*, [29], citing *Samsung Electronics (UK) Ltd v Apple Inc* [2013] ECDR 1 and [2013] FSR 9; see also *PepsiCo v Grupo Promer* (Case C-281/10P) EU:C:2011:679 [2012] FSR 5.

¹⁴ *Shnuggle*, [39].

¹⁵ *Shnuggle*, [40].

¹⁶ *Shnuggle*, [46]. Relevant constraints included the need for baby baths to fit babies of different sizes and shapes, and that the baths should be light enough to be portable, stable and sufficiently spacious in use, and easily stackable during manufacture, distribution and retail.

¹⁷ *Shnuggle*, [47].

¹⁸ *Shnuggle*, [48] and [49].

Soak'.¹⁹ However, Clarke J rejected Munchkin's argument that it was common for the sides of baby baths to be shaped in a concave exterior curve from top to bottom. The 'vast majority' of baby baths in the design corpus were either straight-sided or had sides with a convex exterior curve.²⁰

Clarke J dealt with one further preliminary matter, relating to the design representations used in RCD-196. As Figure 2 shows, in those design representations the body of the bath was coloured blue. Shnuggle argued that, through the tonal differences in the rendering, this colouration was intended only to show the shape of the bath. This argument was rejected by Clarke J. Following the UKSC in *Magmatic* and noting that Shnuggle could have used a simple line drawing (as it had for RCD-763) or grey monochromatic shading, it was held that the design in RCD-196 was registered in blue.²¹ This colouration was a limit on the scope of protection for RCD-196.

In light of all of these findings, Clarke J turned to the comparison of the overall impressions produced by RCD-196 and the 'Sit & Soak', evaluating a series of similarities and differences relied upon by the parties.²² In her view, the main similarities between the two designs were in the shape and proportions of their bodies and pedestals, particularly the profile of the body of each bath as it rose and flared out from the base: that 'elegant externally concave rise from an oval base' which both designs shared was not seen elsewhere in the design corpus.²³ Importantly, however, in Clarke J's view there were also differences between the designs to which the informed user would attach significant weight: the extended tear-drop shape of the top of the back of the 'Sit & Soak' (contrasted to the oval shape of the top of RCD-196); the thin 'airy and floating' edge around the front of the 'Sit & Soak' (contrasted to the thicker 'solid' rim around the whole of RCD-196); the handle in the back section of the 'Sit & Soak' (contrasted to RCD-196's less visible side handles); the particular configuration and contrast colour of the back pad extending up into the lengthened back section of the 'Sit & Soak' (there being no back pad at all in RCD-196); and the presence of the contrast-colour drain in the 'Sit & Soak'.²⁴ Other points which were less important but nonetheless noticeable to the informed user included the different shapes of the bum bump in RCD-106 and in the 'Sit & Soak', and their colour differences.²⁵ Overall, Clarke J concluded that the 'Sit & Soak' produced a different overall impression to RCD-106 and, as a result, did not infringe.²⁶ This would have been so even if RCD-196 had not been limited to the colour blue.²⁷

In relation to RCD-763, the main issue was Munchkin's challenge to validity for lack of individual character. Given RCD-763's later filing date, the earlier public domain designs against which individual character was to be assessed included both the Shnuggle Mk 1 and Shnuggle's earlier-filed RCD-196. Munchkin submitted that RCD-763 was very similar to Shnuggle's earlier designs.²⁸ Counsel for Shnuggle countered with the argument that, given various similarities between the 'Sit & Soak' and RCD-763, if the 'Sit & Soak' produced a different overall impression to RCD-196, so too RCD-763 should

¹⁹ *Shnuggle*, [49].

²⁰ *Shnuggle*, [49].

²¹ *Shnuggle*, [34]-[37] and [50]-[52], following *PMS International Group Plc v Magmatic Limited* [2016] UKSC 12. Clarke J also rejected arguments by Shnuggle that the colouring in RCD-196 was, in fact, off-white or a blue-grey monochrome: *Shnuggle*, [52].

²² *Shnuggle*, [54]-[55].

²³ *Shnuggle*, [56].

²⁴ *Shnuggle*, [57].

²⁵ *Shnuggle*, [57].

²⁶ *Shnuggle*, [58]-[59].

²⁷ *Shnuggle*, [58].

²⁸ *Shnuggle*, [60]; see also [61] and [62].

also be taken to produce a different overall impression to RCD-196. On that basis, RCD-763 would be valid.²⁹ Clarke J disagreed, however, and favoured Munchkin's submissions. None of the differences between Shnuggle's two RCDs were sufficient to create a different overall impression between them.³⁰ In any event, had RCD-763 been valid, due to the differences between them it would not have been infringed by the 'Sit & Soak'.³¹

Shnuggle's UK UDR claims

Shnuggle also claimed infringement of six differently-formulated UK UDR designs which were said to subsist in the Shnuggle Mk1 and Mk2. According to section 213(2) CDPA 1988, UK UDR can be claimed in 'the design of the shape or configuration (whether internal or external) of the whole or part of an article'. To be protected, the design in which UK UDR is claimed must be 'original': this requires both originality in the copyright sense and that the design not be 'commonplace' in the design field in question at the time of its creation.³² UK UDR is infringed *inter alia* by reproducing the protected design by making articles exactly or substantially to the design.³³

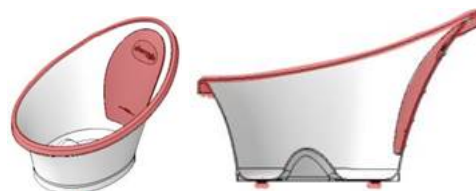
Shnuggle did not claim UK UDR protection for the entirety of either of the Shnuggle Mk1 or Mk2. Instead, Shnuggle focussed its case on various elements of the two baths. Four of the designs in which Shnuggle claimed UK UDR protection in this way are illustrated at Figure 3, using the numbering scheme in the judgment. The elements for which UK UDR protection was claimed are shown in white; excluded elements, not said to form part of the protected designs, are shown in pink.

Figure 3: Shnuggle's UK UDR claims (from Annex 3 to Clarke J's judgment)

Design (1)



Design (2)



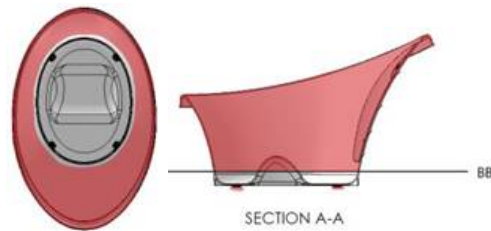
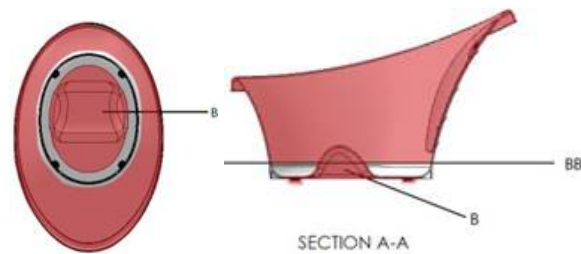
²⁹ *Shnuggle*, [64]

³⁰ *Shnuggle*, [61] and [65].

³¹ *Shnuggle*, [66].

³² Sections 213(1) and (4) CDPA 1988.

³³ Sections 226(1) and (2) CDPA 1988.

Design (5)**Design (6)**

In effect, Shnuggle claimed protection in progressively smaller and smaller portions of its baths. For example, Design (1) was said to comprise the external shape of the sides of the Shnuggle Mk1 below the line marked “AA” in the illustration at Figure 3. Design (2) was said to comprise shape of the whole of the Shnuggle Mk2 excluding the roll top, padded backrest and feet upon which the bath rested. Designs (3) and (4) (not shown at Figure 3) consisted of variants on Design (2), excluding further features. Design (5) was a variant on Design (2) claiming protection only for the elements below the line marked ‘BB’. Design (6) claimed even less, mirroring Design (5) but also excluding the area marked ‘B’ (the bum bump).

Formulating Shnuggle’s case in this way engaged on-going uncertainty surrounding the impact of the 2014 reform of the definition of UK UDR-protectable ‘design’ at section 213(2) CDPA 1988. Previously, this definition had covered ‘any aspect of’ the shape or configuration of the whole or part of an article. The reference to ‘any aspect’ of shape or configuration did not require the design feature for which protection was claimed to be significant: any discernible or recognisable element of shape or configuration was sufficient.³⁴ However, there was concern that this approach allowed a UK UDR claimant tactically to ‘trim his design right claim to most closely match what he believes the defendant to have taken’.³⁵ Permitting claimants to focus on unduly small ‘aspects’ of the relevant shape or configuration as constituting their entire protected UK UDR ‘design’ could, in turn, lead to ‘a distorted impression of what the defendant ha[d] done’;³⁶ a defendant might have copied all of that very small ‘aspect’ (and thus infringe), but in fact have produced an overall article which looked very different to the claimant’s product.

These concerns led to the deletion in 2014 of the words ‘any aspect of’ from the definition of UK UDR ‘design’.³⁷ In its current form (quoted above), it is now only the reference to ‘part of an article’ which permits UK UDR claims for something less than the shape or configuration of the article as a whole. The issue which arose in *Shnuggle* was whether, in light of the 2014 reforms, Shnuggle’s Designs (1)-(6) could properly be regarded as being for protectable ‘parts’ of an article. This question was particularly relevant to those of Shnuggle’s claims – such as Designs (5) and (6) – where protection was claimed for only very limited portions of the bath as a whole.

Reviewing key pre-2014 authorities, Clarke J observed that the old case law requirement for a protectable ‘aspect’ to be merely discernible or recognisable had set ‘a very low threshold which is hardly a threshold

³⁴ *A Fulton v Totes Isotoner (UK) Ltd* [2004] RPC 16, [31]; *Dyson Ltd v Qualtex (UK) Ltd* [2006] RPC 31, [22].

³⁵ *Ocular Sciences Ltd v Aspect Vision Care Ltd* [1997] RPC 289 p422, quoted *Shnuggle*, [75].

³⁶ *Virgin Atlantic Airways Ltd v Premium Aircraft Interiors Group Ltd* [2009] ECDR 11, [29].

³⁷ By section 1(1) of the Intellectual Property Act 2014.

at all'.³⁸ Clarke J considered more recent cases which have discussed the impact of the 2014 reform, focussing on comments by HHJ Hacon in *DKH Retail v H Young Operations* and the late Carr J in *Neptune v Devol*.³⁹ In these two cases, the view had been expressed that what the 2014 amendment to section 213(2) had removed from UK UDR protection were 'abstract' or 'disembodied' designs – that is, something other than designs specifically embodied in a 'concrete' part of the relevant article.⁴⁰ A hypothetical example given in *Neptune* was a claim for the combination of the end of the spout and the top portion of the lid of a teapot, both of which are disembodied from each other in terms of the article as a whole.⁴¹

Clarke J in *Shnuggle* developed this further. In Clarke J's view, given the deletion of the words 'any aspect of', there was 'no longer any practical utility' to trying to distinguish between 'aspects' and 'parts' of an article.⁴² In her view, the relevant question was simply whether there is a design for 'part' of an article.⁴³ Noting that the Explanatory Notes accompanying the 2014 reforms indicated that the intention had been to limit protection for 'trivial features' of designs,⁴⁴ Clarke J concluded that a 'part' of an article for the purposes of section 213(2) is:

'an actual, but not abstract part which can be identified as such and is not a trivial feature'.⁴⁵

On the facts, Clarke J was satisfied that each of Designs (1) to (6) was for an actual and not abstract part of the relevant baby bath.⁴⁶ On the question of whether any of the parts claimed by Shnuggle were merely trivial, Clarke J hesitated over Design (6) but ultimately concluded that all of Designs (1)-(6) fell within the definition of potentially protectable 'design'.⁴⁷

There was another point of legal uncertainty on the correct legal test to be applied on the requirement for originality. Following the classically low UK copyright originality test, in UK UDR what has been required for the first limb of the originality test is simply that the design in question not have been copied from any previous design and that the author have expended sufficient labour, skill and effort.⁴⁸ However, as a result of the CJEU's decision in *Infopaq* and subsequent copyright cases, the originality test in UK copyright law has become more demanding: what is now required is that the relevant work constitute the author's 'own intellectual creation'.⁴⁹ Existing UK UDR case law was split on whether the new copyright test should also apply to UK UDR.⁵⁰

³⁸ *Shnuggle*, [83].

³⁹ *DKH Retail Ltd v H Young (Operations) Ltd* [2014] EWHC 4034 (IPEC) and *Neptune (Europe) Ltd v Devol Kitchens Ltd* [2017] EWHC 2172 (Pat), cited at *Shnuggle*, [80]-[81] and [84]-[86].

⁴⁰ *DKH Retail*, [16]; *Neptune*, [44].

⁴¹ *Neptune*, [44].

⁴² *Shnuggle*, [91].

⁴³ *Shnuggle*, [91].

⁴⁴ *Shnuggle*, [84] and [91].

⁴⁵ *Shnuggle*, [92].

⁴⁶ *Shnuggle*, [100]. As Clarke J put it, 'you could take several Shnuggle Mk 2 baths and chop them up in accordance with the Shnuggle Designs (2) to (6)... What you would be left with in each case is a single embodied part of the bath in which design right is claimed': *Shnuggle*, [101].

⁴⁷ *Shnuggle*, [102]. Clarke J also rejected Muchkin's argument that, to qualify for protection as 'part' of an article, the 'part' had to be something which was created separately from the rest of the article: *Shnuggle*, [87]-[90].

⁴⁸ *Shnuggle*, [93].

⁴⁹ *Shnuggle*, [94], citing *Infopaq International A/S v Danske Dagblades Forening* (C-5/08) EU:C:2009:465 [2009] ECDR 16.

⁵⁰ *Shnuggle*, [93] and [94].

In this case, Munchkin argued that the *Infopaq* test for originality should apply. Clarke J noted the differing views in existing case law, but declined to decide the point: in her view, it made no difference which test was applied.⁵¹ On the facts, the originality of Design (1) (based on the exterior of the Shnuggle Mk 1) was accepted.⁵² For the UK UDR design claims based on the Shnuggle Mk 2, however, the position was more difficult. The evidence indicated that the Shnuggle Mk 2 had been designed using the Shnuggle Mk 1 as a starting point.⁵³ The changes made thereafter were held to be insufficient to confer originality on Designs (2) to (4), which were not validly protected in UK UDR.⁵⁴

This cut Shnuggle's UK UDR case cut down to Designs (1), (5) and (6). Shnuggle's position continued to weaken. Turning to the second part of the originality test, it was held that Design (6) was commonplace.⁵⁵ This left only Designs (1) and (5), but neither was held to be infringed. Only Design (1) had been copied in the sense required for UK UDR infringement; insofar as it shared similarities with Design (5), the 'Sit & Soak' was the product of an independent exercise of design.⁵⁶ Furthermore, the 'Sit & Soak' did not 'exactly or substantially' reproduce Design (1). Munchkin had only copied the shape of the sides of the tub and above where, in the 'Sit & Soak', the tub curved substantially under the flange.⁵⁷ In Clarke J's view, this was not a substantial copy of the whole of Design (1): the curve where the 'Sit & Soak' walls met the base was quite different to Design (1), the 'Sit & Soak' base was commonplace insofar as similar to Design (1) and was different with regard to the external shape caused by the differently-designed bum bump among other points of detail.⁵⁸ The upshot was that none of Shnuggle's UK UDR claims succeeded.

Comment

On the RCD-related issues arising in this case, it is notable to see the principles on interpretation of design representations articulated by the UKSC in *Magmatic* being applied: although not determinative of the case, in relation to RCD-196 Shnuggle appears to be yet another RCD design litigant hampered by poor choices in its design representations.

Beyond this, the case law applied by Clarke J on the characterisation of the informed user, design corpus, design constraints and comparison of overall impression is generally well-established. Some on-going questions over exactly what design constraints are legally relevant were potentially engaged, but not discussed.⁵⁹ The judgment appears to some extent erroneously to elide the exclusion from protection for design features 'solely dictated by technical function' with the requirement to take account of design constraints when assessing individual character.⁶⁰ Clarke J also drew a distinction between 'design

⁵¹ *Shnuggle*, [95].

⁵² *Shnuggle*, [103].

⁵³ *Shnuggle*, [107]-[108].

⁵⁴ *Shnuggle*, [113]-[114].

⁵⁵ *Shnuggle*, [132]; see [122]-[134] more generally in relation to Designs (1) and (5).

⁵⁶ *Shnuggle*, [135]-[164].

⁵⁷ *Shnuggle*, [166].

⁵⁸ *Shnuggle*, [166].

⁵⁹ There is an on-going lack of clarity in UK case law as to whether the only relevant design constraints are those imposed by the technical function of the product and/or statutory requirements, or may extend more broadly to, for example, economic considerations. Clarke J cites case law supporting the former view, but later also refers to 'constraints of volume manufacture and sale': *Shnuggle*, [33] and [44]. See also n.16 above.

⁶⁰ *Shnuggle*, [31] and [44].

constraints’ and ‘design objectives’ – the former being relevant to assessment of overall impression, the latter not – which was not fully explained.⁶¹ That said, however, these points do not appear to have been of major import to the overall decision.

The key interest in this case from an RCD perspective is as an exemplar of established case law principles in action. To the untutored eye, Shnuggle’s RCDs and the ‘Sit & Soak’ share a good number of similar design features. On the evidence, however, many of those similarities were found to be common to the design corpus, and thus of little or no weight in the comparison of overall impression when viewed from the perspective of the informed user. The differences between the ‘Sit & Soak’ and Shnuggle’s designs were key. It was, in particular, the extended tear-drop shape of the top of the ‘Sit & Soak’, the handle in the top of its back section, the particular shape and contrast colour of its lengthened back pad and its partial ‘floating’ rim which all combined to create a different overall impression. *Shnuggle* serves as a salutary reminder that, even where an alleged infringement is clearly inspired by features appearing in an earlier RCD, it is nonetheless possible that, in evolving his design, the alleged infringer will have done enough visually to differentiate his design such that it no longer produces the same overall impression.

As far as Shnuggle’s UK UDR claims are concerned, the judgment provides an excellent example of how the sequence of requirements for UK UDR protection and infringement can steadily cut down attempts to rely on multiple increasingly small combinations of design features as a way of targeting infringement claims. Shnuggle’s formulation of its UK UDR case attempted to ‘trim’ out of consideration the features of the ‘Sit & Soak’ which were most different to the Shnuggle Mk 1 and 2 (particularly the extended tear-drop back, handle, back pad and rim), but framing the case this way pushed at the boundaries of what might be acceptable after the 2014 reform of the definition of protectable ‘design’, particularly in relation to Shnuggle’s most narrowly-constructed UK UDR claims. In the end, however, even this tactic of claiming ever-smaller portions of the Shnuggle product did not work as each of Designs (1) to (6) fell steadily by the wayside.

This case study in the (unsuccessful) tactical pleading of UK UDR is interesting in itself. Going beyond this, however, *Shnuggle* highlights a real need for appellate-level clarification of two significant legal issues. The first of these is the impact of the 2014 reform of the definition of ‘design’ at section 213(2) CPDA 1988. It is respectfully suggested here that the focus among the lower-level courts on the supposed problems of ‘abstract’ or ‘disembodied’ design elements is misplaced. Although the point was not explored by Clarke J, *DKH Retail* and *Neptune* are really directed at two different perceived problems. The cited comments from *Neptune* relate to design elements which are present in the actual shape of the claimant’s article, but are ‘disembodied’ in the sense of not being physically connected to each other: if the rest of the article were cut away, the offending elements would ‘float’ separately to one another. It is by no means clear that this sort of claim should be regarded as unacceptable for UK UDR purposes: this style of claiming can, for example, be found in registered designs. The concerns expressed in *DKH Retail* were directed at the separate issue, arising in some cases, of a style of generalised, almost patent-like, abstract claiming for the presence of broadly-defined design features which are not, at least as pleaded, restricted to the specific actual appearance of the claimant’s article. Howe rejects as a ‘heresy’ the notion that this kind of abstract claiming has ever been possible;⁶² either way, the comments on ‘any aspect’ in *DKH Retail* were linked to parallel discussion of the persistently problematic (and entirely separate)

⁶¹ *Shnuggle*, [46], indents (ii) and (iii).

⁶² M Howe, *Russell-Clarke and Howe on Industrial Designs* (9th edn, 2016), para 4-007, footnote 22.

concept of ‘configuration’ in section 213(2).⁶³ There are well-known concerns that the notion of ‘configuration’ may permit this kind of more generalised abstract claiming,⁶⁴ and it is possible that those concerns have inadvertently spilled over into the courts’ approach to the deletion of ‘any aspect’ from section 213(2).

In any event, it is clear from the Explanatory Memorandum to the Intellectual Property Act 2014 (quoted above) and the preceding exercise of public consultation that ‘abstract’ or ‘disembodied’ designs were not the problem to which the 2014 reform of section 213(2) was directed. The UK IPO consultation document which opened the consultation process in 2012 stated clearly that the concerns over the ‘any aspect of’ wording related to the potential for the claiming of unduly small design elements:

‘... the effect of this wide definition of the scope of protection is to load the dice too heavily in favour of existing design owners. They can easily establish that a new and competing design infringes theirs by basing that claim on a very small and ‘cropped’ part of their design. In this way they can say that another design article infringes theirs even when the overall appearance of that article is not very similar at all’.⁶⁵

These comments were repeated in the UK Government response to the consultation process in 2013, where it was again explicitly identified that the problem related to claims based on ‘a very small and ‘cropped’ part of an article’.⁶⁶ Clarke J was correct in *Schuggle* to conclude that, to be a protected UK UDR design for ‘part’ of an article, post-2014 the relevant design features must be non-trivial, but this is as far as the test should go: whether ‘disembodied’ design claiming is problematic requires more developed reflection, and any concerns over generalised, patent-style ‘abstract’ claiming should be tackled through clarification or even reform of the concept of ‘configuration’.

The second issue requiring appellate-level clarification is the impact, if any, on UK UDR of copyright law developments on the concept of ‘originality’. Although Clarke J indicated that she preferred not to decide this issue, the judgment nonetheless applied the ‘author’s own intellectual creation’ test to *Shnuggle*’s UK UDR claims.⁶⁷ There is a real danger that the *Infopaq* test may become absorbed into first instance UK UDR case law without the necessary detailed consideration of whether this is appropriate. It is submitted here that courts should strongly resist moves to transpose CJEU-led copyright developments into the UK UDR context. UK UDR long predates the EU’s activity in copyright law, and is a home-grown national IP right that stands apart from EU harmonisation of either copyright or design law. CJEU copyright decisions such as *Infopaq* are quite simply irrelevant. The ‘author’s own intellectual creation’ test is in any event substantively entirely unsuitable. As developed by the CJEU, the originality test requires that a copyright work must reflect the author’s personality and express free and creative choices in the production of that work.⁶⁸ This implies a need for a degree of personal creative expressiveness which runs directly counter to one of the fundamental features of UK UDR, which

⁶³ *DHK Retail*, [8].

⁶⁴ See, for example, the comments by Arnold J in *Magmatic Ltd v PMS International Ltd* [2014] RPC 23, [90]-[93].

⁶⁵ UK IPO, ‘Consultation on the Reform of the UK Designs Legal Framework’, July 2012 (available at <http://data.parliament.uk/DepositedPapers/Files/DEP2012-1279/designsconsultationdoc.pdf>), paragraph 4.9.

⁶⁶ UK IPO, ‘The Consultation on the Reform of the UK Designs Legal Framework Government Response - April 2013’ (available at <https://patentlyo.com/media/docs/2013/04/response-2012-designs.pdf>), paragraph 24; see also paragraph 28.

⁶⁷ *Shnuggle*, [113].

⁶⁸ *Painer v Standard Verlags GmbH* (C-145/10) EU:C:2011:798 [2012] ECDR 6, [94]; *Land Nordrhein-Westphalen v Dirk Renckhoff* (C-161/17) EU:C:2018:634 [2018] ECDR 21, [14].

protects even wholly functional designs. In such cases, while there may be complex technical choices to resolve, there is no scope for a designer to inject ‘personality’ or ‘expressive’ creative choices into his design efforts.⁶⁹ There is still a role in UK UDR for the traditional UK originality standard; while *Infopaq* may sweep across the copyright landscape, as regards UK UDR at least the UK courts would do well not to throw the baby out with the bathwater.

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⁶⁹ *Landor & Hava International Ltd v Azure Designs Ltd* [2007] FSR 9, [16].